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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/720,377	11/25/2003	Katsuyuki Shimasaku	31238-199054	4281
26694	7590	07/08/2005	EXAMINER	
VENABLE LLP			ROSS, DANA	
P.O. BOX 34385			ART UNIT	
WASHINGTON, DC 20045-9998			PAPER NUMBER	

3722

DATE MAILED: 07/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/720,377

Applicant(s)

SHIMASAKU ET AL.

Examiner

Dana Ross

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 November 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---------------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>11/15/03</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. There is no Election/Restriction requirement at this time. However, Examiner notes that a combination/subcombination restriction or a species election may be required in the next office action depending on the amended claim language which will further clarify Applicant's claimed invention.

Drawings

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. It is not clear, but it appears that claim 4 is directed towards an undisclosed embodiment wherein the pull head and retrieving head of claim 1 "are both pull heads provided with pull mechanisms" as claimed in claim 4. This feature must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet"

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pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-7 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim 1, it is not clear how there is a “means for firmly connecting the heads and the broach together” by “pressing and clamping the tapered surface of the broach against the tapered inner surface of the head”. It appears that this would only provide for one head and one end to be firmly connected. It is not clear what is being claimed.

Claim 4, it is not clear from the disclosure what is being claimed by “...said heads are both pull heads each provided with pull mechanisms for pulling the broach...”. It is not clear what is being claimed. Claim 1 has the limitation of two heads, a pull head and a retrieving head. It is not clear what is being claimed by making the retrieving head a second pull head. It is further not clear what Applicant means by having a “means for pressing” comprises a “pull mechanism”.

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Claim 5, it is not clear how the “pull mechanism” has a pair of “engagements grooves” formed on an end of the “broach”. (see page 18, lines 2-15). Furthermore, it is not clear from the disclosure what is being claimed by “the pull mechanism”.

The above is not all-inclusive of the 35 USC 112 1st paragraph issues. Applicant is required to review all claims to ensure compliance with the enable requirement of 35 USC 112 1st Paragraph.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors.

Claim 1, line15, recites the limitation "the head". There is insufficient antecedent basis for this limitation in the claim. There are two heads claimed previous, a pull head and a retrieving head. It is not clear which head is being referenced. It is further noted that the claims regularly refer to “the head” throughout, making the claims unclear as to what Applicant is claiming. See claim 3, lines 2 and 4 and claim 4, line 2 and 8 as examples of the terminology “the head” which lack further antecedent basis due to the multiple heads that have been claimed.

Claim 5, line 2, recites the limitation "said pull mechanism". There is insufficient antecedent basis for this limitation in the claim.

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The above is not all-inclusive but examples of the lack of antecedent basis in the claims. Applicant is required to review all claims to ensure compliance with all aspects of 35 USC 112 2nd paragraph.

All claims will be examined as best understood.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-4, 7 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by US Pat. No. 5,833,411 (Holstein et al., hereafter '411).

'411 teaches an internal broaching machine with a broach 17 with two ends (either end is considered the pull end or follower end) with two heads 24 and 28 (retrieving and pulling) for holding the two ends of the broach (see fig. 4, and col. 3, lines 1-59, for example); each end of the broach 17 with a taper (see fig1 and 5, for example) for connecting the ends to the heads; a sliding table 3, 4, 7 or 8 (see fig. 1 and 4, for example) and a movable block 7 mounted on the slide table 3, 4 or 6 and drivingly connected to the drive cylinder 22, 27 (see fig. 3, for example).

9. Claim 8 is rejected under 35 U.S.C. 102(b) as being anticipated by US Pat. Pub. 2002/0015622 (Nakamura et al., hereafter '622).

'622 teaches a broach used in internal broaching with two ends and a tapered grip surface formed on at least one end (see figure 1, page 2, paragraph 0025, for example).

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Allowable Subject Matter

10. Examiner notes that no prior art could be found that incorporates the limitations of claims 1, 2 and 5 or claims 1 and 6, as currently claimed and as best understood. However, upon resolution of the 35 USC 112 1st and 2nd Paragraph rejections, examiner further notes that the allowability of this subject matter may be withdrawn.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

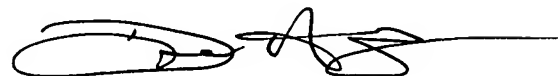
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dana Ross whose telephone number is 571-272-4480. The examiner can normally be reached on Mon-Thurs.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on 571-272-4419. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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